



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ibraheem BADEJO et al.

Application No.: 09/964,415

Filed: September 28, 2001

For: ADHESIVE COMPOSITIONS CONTAINING DUAL FUNCTION STABILIZERS
AND ACTIVE AGENTS

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Group Art Unit: 1654

Examiner: P. PATTEN

Docket No.: 108773

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

Director of the U.S. Patent and Trademark Office
Washington, D. C. 20231

Sir:

In response to the combined Restriction and Election of Species Requirement mailed December 17, 2002, Applicants respond as follows.

I. Restriction Requirement

The Office Action asserts a Restriction Requirement between Groups I (claims 1-31 and 64), II (claims 32-63), and III (claims 65-66). In response, Applicants elect Group I, claims 1-31 and 64, with traverse. Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement.

A. The Restriction Requirement Should be Withdrawn

The Restriction Requirement asserts that Group I is distinct from Groups II and III, noting that Groups I and II are related as process of making and product made, and Groups II and III are unrelated. Although Applicants agree that the inventions of Groups I and II and III may be independent or distinct as claimed, Applicants respectfully submit that the Restriction Requirement between Group I and Groups II and III is improper, and should be withdrawn.

According to MPEP §803, there are ~~two~~ requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required . . . " (emphasis added). Applicants respectfully submit that the Office Action has failed to establish the second requirement set forth in MPEP §803, that a serious burden exists on the Examiner if restriction is not required between the Groups of claims.

In the present application, Group I is directed to a composition. Group II is directed to a method of making the composition of Group I, and Group III is directed to a method of using the composition of Group I. Applicants respectfully submit that a search for the subject matter of Group I would be commensurate with a search for the subject matter of Groups II and III. Accordingly, search and examination of the subject matter of Group I would encompass a search for the subject matter of Groups II and III, and any additional search would not impose a serious burden upon the Examiner.

It is therefore respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). Because Applicants have elected Group II, directed to an applicator, the further search and examination of Group I, directed to a kit comprising an applicator and applicator tips, would not place a serious burden upon the Examiner.

For at least these reasons, and in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

B. Rejoinder Will in Any Event be Required

As mentioned above, and admitted in the Office Action, Group I is directed to a composition. Group II is directed to a method of making the composition of Group I, and Group III is directed to a method of using the composition of Group I.

Where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. *Id.*

In the present application, the method claims of Groups II and III include all of the limitations of the product of Group I. In particular, all of the limitations of the independent product claim 1 of Group I are incorporated into the method of Groups II and III, since at least claims 32 (Group II) and 65 (Group III) depend directly from claim 1.

Since the method claims of Groups II and III include the limitations of the product claims of Group I, the method claims must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

II. Election of Species Requirement

The Office Action requires election of a sub-genus of the at least one stabilizer of claim 1, and a particular species of such sub-genus. In response to the Election of Species Requirement, Applicants hereby elect the sub-genus where the at least one stabilizer is an herbal extract, and the particular species where the at least one stabilizer is tetrahydrocurcumin. This election is made with traverse.

In further response to the Election of Species Requirement, Applicants respectfully assert that at least claims 1, 32, 33, 34, and 65 are generic to the elected species. Applicants respectfully assert that at least claims 1-5, 7-8, 18-45, and 6 read on the elected species.

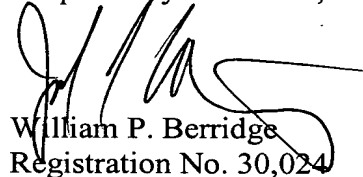
Applicants traverse the election of species requirement on the ground that the generic claims are not so broad as to place an undue burden on the Patent Office to search and examine the full scope of the claims. Rather, Applicants respectfully assert that search and examination of the entire application could be conducted without undue burden on the Examiner, thus avoiding delay and expense to Applicants.

Applicants further understand, however, that upon search, examination and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims.

III. Conclusion

Early and favorable consideration of the application are respectfully requested. Should the Examiner have any questions regarding the application, or any suggestions to expedite prosecution, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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